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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,209	03/28/2001	Satoshi Kyotoku	B422-146	2354
26272	7590	09/30/2004		
COWAN LIEBOWITZ & LATMAN P.C. JOHN J TORRENTE 1133 AVE OF THE AMERICAS 1133 AVE OF THE AMERICAS NEW YORK, NY 10017			EXAMINER PYZOCHA, MICHAEL J	
			ART UNIT	PAPER NUMBER
			2137	

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,209

Applicant(s)

KYOTOKU, SATOSHI

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. Claims 1-33 are pending.

Priority

2. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Japan on 31 March 2000 and 25 April 2000. It is noted, however, that applicant has not filed a certified copy of the 096472/2000 and 124827/20004 applications as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-3, 6-9, 12-15, 18-19, 21, 23, 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Schneier et al (U.S. 5,871,398).

As per claims 1, 7 and 13, Schneier et al discloses a software execution method, apparatus, and program comprising a detection step of detecting a location; and a termination step of terminating the execution of software in accordance with said location (see column 14 lines 33-48).

As per claims 2, 8 and 14, Schneier et al discloses at the termination step, the execution of said software is terminated at a location other than a predetermined location (see column 14 lines 33-48 where the predetermined locations are where gaming is permissible).

As per claims 3, 9 and 15, Schneier et al discloses at the detection step, a location is detected from a GPS signal received by a GPS receiver (see column 14 lines 33-48).

As per claims 6, 12 and 18, Schneier et al discloses at the termination step, information written on a part is read and the execution of software is terminated in accordance with said information and said detection location (see column 14 lines 33-48 where the part is the memory 103 of FIG. 6).

As per claims 19, 21 and 23, Schneier et al discloses a software execution method, apparatus and program comprising a

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reception step of receiving a GPS signal from a GPS receiver and a termination step of terminating the execution of software in accordance with said GPS signal (see column 14 lines 33-48).

As per claim 29, Schneier et al discloses information acquisition means for externally obtaining location information and halting means for halting the execution of software in accordance with a comparison of said location information with information written in said software (see column 14 lines 33-48).

As per claim 30, Schneier et al discloses the information acquisition means obtains the location information from a GPS receiver (see column 14 lines 33-48).

5. Claims 26, 31-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Teare et al (U.S. 5,243,652).

As per claim 26 Teare et al discloses a remote access control apparatus comprising determination means for determining the location of a remote access station (see column 3 lines 19-29) and control means for terminating a remote access in accordance with said location of said remote access station (see column 3 lines 30-47).

As per claim 31, Teare et al discloses a network system wherein remote access is performed between a first apparatus and a second apparatus; wherein said first apparatus includes

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location information acquisition means for obtaining location information for said first apparatus, and transmission means for transmitting said location information obtained by said location information acquisition means (see column 3 lines 4-18); and wherein said second apparatus includes reception means for receiving said location information from said transmission means, and disconnection means for halting a remote access in accordance with said location information received by said reception means (see column 3 lines 19-47 where disconnection is not transmitting the key not allowing the remote user to view the file).

As per claim 32, Teare et al discloses a remote access execution apparatus comprising location information acquisition means, for obtaining location information for said remote access execution apparatus (see column 2 line 64 through column 3 line 3); and transmission means, for transmitting to a predetermined apparatus, while remotely accessing said predetermined apparatus, said location information that is obtained by said location information acquisition means in order to notify an apparatus for which remote access is permitted (see column 3 lines 19-47).

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6. Claims 1, 5, 7, 11, 13, 17, 19-24, 29-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Hastings et al (U.S. 6,370,629).

As per claims 1, 7, and 13, Hastings et al discloses a software execution method, apparatus, and program comprising a detection step of detecting a location; and a termination step of terminating the execution of software in accordance with said location (see column 4 lines 18-26 where the software is that in which grants access to the information and it is inherent that it would stop the execution when not in the correct time or location and see column 5 lines 52-61 where the use of location information is disclosed).

As per claims 5, 11, and 17, Hastings et al discloses at the termination step, the execution of remote access software is terminated (see column 4 lines 18-26).

As per claims 19, 21 and 23, Hastings et al discloses a software execution method, apparatus and program comprising a reception step of receiving a GPS signal from a GPS receiver and a termination step of terminating the execution of software in accordance with said GPS signal (see column 4 lines 18-26 where the software is that in which grants access to the information and it is inherent that it would stop the execution when not in the correct time or location).

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As per claims 20, 22, and 24 Hastings et al discloses a software execution method, apparatus and program wherein the termination step the execution of software is terminated in accordance with time information included in said GPS signal (see column 4 lines 18-26).

As per claim 29, Hastings et al discloses information acquisition means for externally obtaining time and/or location information and halting means for halting the execution of software in accordance with a comparison of said time and/or location information with information written in said software (see column 4 lines 18-26 and column 5 lines 52-61).

As per claim 30, Hastings et al discloses the information acquisition means obtains the location information from a GPS receiver (see column 4 lines 18-26 and column 5 lines 52-61).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 4, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneier et al as applied to claims 1, 7, 13 above, and further in view of Graef et al (U.S. 6,083,269).

As per claims 4, 10, 16, Schneier fails to disclose the software being software for controlling semiconductor manufacturing procedures.

However Graef et al discloses the use of software for controlling semiconductor manufacturing procedures.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Graef's software in Schneier's method of controlling software execution.

Motivation to do so would have been to remotely control the production of semiconductors.

9. Claims 4, 10, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al as applied to claims 1, 7, 13 above, and further in view of Graef et al (U.S. 6,083,269).

As per claims 4, 10, 16, Hastings fails to disclose the software being software for controlling semiconductor manufacturing procedures.

However Graef et al discloses the use of software for controlling semiconductor manufacturing procedures.

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Graef's software in Hastings' method of controlling software execution.

Motivation to do so would have been to remotely control the production of semiconductors.

10. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hastings et al and further in view of Martin (U.S. 5,618,232).

Hastings et al discloses monitoring apparatus comprising first reception means, for receiving a notification signal from a monitor target apparatus; second reception means, for receiving a GPS signal; and monitoring means, for employing said notification signal and said GPS signal to monitor the software used by said monitor target apparatus (see column 5 lines 29-61 where the notification signal is the password and the software is that in which grants access to the information).

Hastings et al fails to disclose using the notification and GPS signals to monitor the legality of the software.

Martin discloses using a GPS signal to monitor the legality of the software (see column 3 lines 36-47).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Hasting et al's system to monitor the legality of software used.

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Motivation to do so would have been to prevent the use of the software illegally.

11. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teare et al.

Teare et al discloses remote access apparatus comprising reading means, for reading apparatus information recorded on in a non-volatile part; and transmission means, for transmitting to a remote access destination, in order to notify an apparatus for which remote access is permitted, said apparatus information obtained by said reading means (see column 2 line 64 through column 3 line 18 where the apparatus information is the location information.

Teare et al fails to disclose the non-volatile part being optical.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use an optical part (such as a CD-ROM) to record the apparatus information.

Motivation to do so would have been that the information on the CD-ROM could not be changed.

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teare et al as applied to claim 27 above, and further in view of Hastings et al.

Teare et al fails to disclose transmitting a GPS signal along with the apparatus information.

However, Hastings et al discloses sending a GPS signal.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the GPS signal of Hastings et al with the apparatus information of Teare et al.

Motivation to do so would have been to control the access of information.

13. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teare et al and further in view of Menezes et al (Handbook of Applied Cryptography).

Teare et al discloses a network system wherein remote access between a first apparatus and a second apparatus is effected; wherein said first apparatus includes location information acquisition means for obtaining first location information for said first apparatus (see column 2 lines 64-66), and transmission means for transmitting said first location information; and wherein said second apparatus includes reception means for receiving said first location information from said transmission means, and disconnection means for halting a remote access in accordance with said first location information (see column 3 lines 19-47).

Teare et al fails to disclose ID information acquisition means for obtaining ID information, including second location information for said first apparatus, and including the ID information in transmission and reception.

However, Menezes et al discloses the use of ID information on pages 22-23 where the message is the location information and the signature is the ID information.

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's ID information with Teare et al's system.

Motivation to do so would have been to provide authentication, authorization and non-repudiation.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chernow et al (U.S. 4,999,806) discloses a software distribution system with access control based on location, Galipeau et al (U.S. 5,799,141) discloses a real-time data protection system for remote computers and Alcorn et al (U.S. 6,104,815) discloses a method for using location/time information to provide authentication.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

Andrew Caldwell
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